



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Noah Dan, et al.

Serial No. 10/617,360 Group Art Unit (unassigned)

Filed July 11, 2003 Examiner (unassigned)

For SYSTEM AND METHOD FOR BUILDING CUSTOM APPLICATIONS
ON AN APPLICATION SERVER

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


STATEMENT OF FACTS
DECLARED BY
NOAH DAN

Sir:

I, Noah Dan, co-inventor of the above captioned invention, declare as follows:

1. On or about November 11, 2004, I received an email (attached as Exhibit A1) from patent counsel reminding me and co-inventor Damon Anderson that we needed to sign a Declaration (attached as Exhibit A2) that we were joint inventors of invention described and claimed in the patent application filed on July 11, 2003 for SYSTEM AND METHOD FOR BUILDING CUSTOM APPLICATIONS ON AN APPLICATION SERVER (attached as Exhibit A3).
2. Thereafter I spoke to co-inventor Damon Anderson, who expressed reservations about signing the Declaration. He told me that he had been contacted by his former employer, FileNet, and he did not want to risk litigation from FileNet, who may assert that the claimed invention was developed while Damon was employed at FileNet.
3. On March 5, 2004 I received a further email (attached as Exhibit B1) from patent counsel, again requesting that co-inventor Damon Anderson and I sign the Declaration (attached as Exhibit A2) that we were the inventors of the invention described and claimed in the application (attached as Exhibit A3). The email included a letter to Damon Anderson (attached as Exhibit B2) specifically addressing the concerns that Damon had discussed with me earlier.
4. On March 8, 2004 I called Damon to confirm that he had received the March 5th email from patent counsel and its attachments, and in particular the attached letter addressed to Damon. I asked him whether he had read the letter. He said he had viewed it briefly. I asked him whether he would now be willing to sign the Declaration. I urged him to sign the Declaration, and to stand up for his rights. He said that he have not changed his mind and he would not sign the Declaration.

5. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application and any patent issuing thereon.

Date: 10 MARCH 04 
NOAH DAN



From: Clyde R Christofferson [clydec@crc-law.com]
Sent: Thursday, March 04, 2004 4:52 PM
To: Noah Dan (noah@the-dans.com); Damon Anderson (damon@spof.net)
Cc: Tobey Marzouk (tmarzouk@mptechlaw.com)
Subject: Patent Application and Declaration

Noah and Damon,

This email essentially repeats the email I sent to both of you last November 11th, asking for signatures on the attached Declaration (on the second page).

Damon, as I understand it from Noah, you had reservations about signing. I have attached a letter that attempts to deal with those reservations. I hope that you will decide to sign the Declaration, as is your right as an inventor. However, if you decide not to sign, the rules allow the Declaration to be filed with Noah's signature alone, so all rights to the invention will be preserved.

The rules permitted us to file the application with an unsigned Declaration and without a filing fee, provided these "missing parts" are later provided. We had until December 14, 2003 to provide what was missing, but can extend the time with an extension of time fee. The next deadline is March 14, 2004.

If each of you will print out the two page Declaration, sign and date it on the second page, fax it to me at 703-787-7557, and then mail the signed original to me at

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

we can complete the filing process.

I have also attached a PDF copy of the application as filed, including drawings, for your reference.

Thanks,

Clyde

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.

INTELLECTUAL PROPERTY LAW

Providing Global Intellectual Property Strategies & Solutions



Michael E. Whitham
 Marshall M. Curtis
 Clyde R. Christofferson
 Robert N. Cook
 C. Lamont Whitham*
 Mary E. Goulet*
 *of counsel

Registered Patent Agents:
 Ruth E. Tyler-Cross, Ph. D
 Olga V. Merkulova
 Daniel A. Steinberg

Law Clerk:
 Philana S. Handler

March 4, 2004

Damon Anderson
 3614 Connecticut Avenue, N.W.
 Washington, DC 20008

Re: Server Bullet technology
 U.S. Patent Application Serial No. 10/617,360
 SYSTEM AND METHOD FOR BUILDING CUSTOM APPLICATIONS ON
 AN APPLICATION SERVER
 Inventors: Noah Dan and Damon Anderson
Our Ref: 07980001aa

Dear Damon:

I have enclosed a copy of the application filed last July, together with a Declaration and Power of Attorney for your signature. As you will recall, we filed the application "incomplete" – that is, without signatures – thereby delaying payment of the filing fee. As is customary for this procedure, we have received from the Patent and Trademark Office a "Notice to File Missing Parts." In order to respond to this Notice, we need the inventors – you and Noah – to sign the attached Declaration and return to me at

Clyde R Christofferson
 WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
 11491 Sunset Hills Road, Suite 340
 Reston, VA 20190

I have enclosed a self addressed envelope for that purpose.

Noah tells me that you have been contacted by your former employer, FileNet, and are concerned about adverse consequences should you sign the application. I do not know what FileNet told you, but I am aware of nothing that should prevent you from signing the Declaration. All it says is that you are a co-inventor and that the application describes the invention.

Technically, Noah's signature on the Declaration is enough. If you do not sign – for whatever reason – after being presented with the application and Declaration, Noah's signature counts for the both of you. The case on this point is *In re Gray*, 115 USPQ 80 (Commissioner of Patents, 1956). The rules are also spelled out in the Manual of Patent Examining Procedure ¶409.03(d).

But I would urge you to sign in your own hand, rather than by default through Noah. You are an inventor and have every right to sign on your own behalf. The circumstances of FileNet's acquisition of some intellectual property from eGrail suggest that FileNet may have been misled by eGrail's management to believe that the server bullet technology was invented by eGrail. From all the facts that I am aware of regarding the history of this invention and the employment arrangements that you and Noah had with eGrail, you and Noah own this invention free and clear of eGrail and FileNet.

It is possible, of course, that FileNet could argue that the invention was developed by you and Noah when you were under a legal obligation to assign your work to eGrail. I don't believe the facts support that view, but that wouldn't prevent FileNet from making the argument. However, the time to make that argument is after the invention has been protected by filing a patent application. Inventions in the United States are always filed in the names of the inventors; assignment is handled separately, which is the point of the negotiation with FileNet.

I would be happy to talk to you further about any questions you have and I would urge you to sign the attached Declaration and Power of Attorney, so that we can properly pursue your rights as an inventor.

Sincerely,

Clyde R Christofferson /e

Clyde R Christofferson

enc.



From: Clyde R Christofferson [clydec@crc-law.com]
Sent: Tuesday, November 11, 2003 9:10 PM
To: Noah Dan (E-mail); Damon Anderson (E-mail)
Cc: Tobey Marzouk (E-mail)
Subject: Patent Application; Declaration

Noah and Damon,

It has come time for you to sign and date the attached Declaration (on the second page) required of the inventors.

The rules permitted us to file the application with an unsigned Declaration and without a filing fee, provided these "missing parts" are later provided. We have until December 14, 2003 to provide what was missing.

If each of you will print out the two page Declaration, sign and date it on the second page, fax it to me at 703-787-7557, and then mail the signed original to me at

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Reston, VA 20190

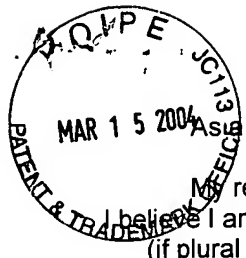
we can complete the filing process.

I have also attached a PDF copy of the application as filed, including drawings, for your reference.

Thanks,

Clyde

DECLARATION AND POWER OF ATTORNEY



As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;
 I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor
 (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the
 invention entitled

SYSTEM AND METHOD FOR BUILDING CUSTOM APPLICATIONS ON AN APPLICATION SERVER

the specification of which:

(check one) ☐ is attached hereto
☒ was filed on 7/11/2003
 as Application Serial No. 10/617,360
 and was amended on

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, § 1.56*

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)		priority Claimed
(Appl. No.)	(Country)	(Filing date)

I hereby claim the benefit under Title 35, United States Code, § 119(e) and/or § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

(Application Serial No.)	(Filing Date)	(Status: patented, pending, abandoned)
<u>60/394,866</u>	<u>July 11, 2002</u>	<u>Pending</u>

and any continuation applications thereof currently pending.

Power of Attorney: As a named inventor, I hereby appoint Michael E. Whitham, Reg. No. 32,635, Marshall M. Curtis, Reg. No. 33,138, Clyde R Christofferson, Reg. No. 34,138, and C. Lamont Whitham, Reg. No. 22,424, as attorneys and/or agents to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. All correspondence should be directed to Whitham, Curtis & Christofferson, P.C., 11491 Sunset Hills Road, Suite 340, Reston, Virginia 20190. All telephone calls should be directed to Clyde R Christofferson at 703-787-9400. Please assign this application to Customer Number 30743.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of First Noah Dan

Inventor's Signature _____ Date _____

Residence 8813 Hidden Hill Lane, Potomac, Maryland 20854

Citizenship US

Post Office Address Same As Above

Full Name of Second Damon Anderson

Inventor's Signature _____ Date _____

Residence 3614 Connecticut Avenue, N.W., Washington, DC 20008

Citizenship US

Post Office Address Same As Above

*Title 37, Code of Federal Regulations, §1.56:

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith toward the Patent and Trademark Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and (1) it establishes, by itself or in combination with other information, a prima facie case of unpatentability; or (2) it refutes, or is inconsistent with, a position the applicant takes in: (i) opposing an argument of unpatentability relied on by the Office, or (ii) asserting an argument of patentability.